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PTO/SB/26 (07-06)

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# TERMINAL DISCLAIMER TO OBTAIN A DOUBLE PATENTING REJECTION OVER A "PRIOR" PATENT

Docket Number (Optional)  
CSP-025549-V1

In re Application of: Sandeep Kulkarni

Application No.: 10/685,899

Filed: 10/15/2003

For: NOVEL PAPER BASED SUBSTRATES AND ARTICLES MANUFACTURED THEREFROM

The owner, International Paper Company, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term prior patent No. 6,645,642 as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said prior patent is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, "as the term of said prior patent is presently shortened by any terminal disclaimer," in the event that said prior patent later:

- expires for failure to pay a maintenance fee;
- is held unenforceable;
- is found invalid by a court of competent jurisdiction;
- is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
- has all claims canceled by a reexamination certificate;
- is reissued; or
- is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record. Reg. No. 52,595

  
Signature

13 October 2006  
Date

Thomas W. Barnes III, Ph.D.  
Typed or printed name

513-248-6736  
Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).  
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: International Paper CompanyApplication No./Patent No./Control No.: 10/685,899Filed/Issue Date: 10/15/2003Entitled: Novel Paper Based Substrates and Articles Manufactured TherefromInternational Paper Company

(Name of Assignee)

, a Corporation

(Type of Assignee: corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or
2. ☐ an assignee of less than the entire right, title and interest  
(The extent (by percentage) of its ownership interest is \_\_\_\_\_ %)

in the patent application/patent identified above by virtue of either:

- A. ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel 013160, Frame 0310, or a true copy of the original assignment is attached.

OR

- B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.
2. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.
3. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

As required by 37 CFR 3.73(b)(1)(i), the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.

(NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.08)

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.



Signature

Loretta M. Shirk

Printed or Typed Name

13 October 2006

Date

513-248-6212

Telephone Number

Assistant Secretary, International Paper Company

Title

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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# BEST AVAILABLE COPY *Assignment*

We, Sandeep Kulkarni, a citizen of India, having a mailing address of 6074 Wedwood Drive, Morrow, Ohio 45152; Yuan Ling, a citizen of the United States, having a mailing address of 5897 Meadow Lark Court, Milford, Ohio 45150; Rick C. Williams, a citizen of the United States, having a mailing address of 31 Eisenhower Drive, Middletown, New York 10940 and Victor P. Holbert, a citizen of the United States, having a mailing address of 1852 Phasant Hills Drive, Loveland, Ohio 45140, for good and valuable consideration, receipt of which is hereby acknowledged, have assigned and do hereby assign to INTERNATIONAL PAPER COMPANY, a New York corporation, having its principal place of business at Two Manhattanville Road, Purchase, New York 10577-2196, its successors, assigns and legal representatives, the entire right, title and interest throughout the world in and to all subject matter invented by us and disclosed in the application identified below.

Title	PAPER ARTICLES EXHIBITING LONG TERM STORAGEABILITY AND METHOD FOR MAKING SAME
Application No.	10/117,358
Filing Date	April 5, 2002
Confirmation No.	6486

and in and to all Letters Patent and all Convention and treaty rights of all kinds, in all countries throughout the world, for all such subject matter. We agree to sign all papers necessary to secure all said Letters Patent to the above assignee in accordance with the Assignment.

7/23/02  
Date of Execution of Assignment  
7/23/02  
Date of Execution of Assignment  
7/29/02  
Date of Execution of Assignment  
7/23/02  
Date of Execution of Assignment

Sandeep Kulkarni  
Sandeep Kulkarni

Yuan Ling  
Yuan Ling

Rick C. Williams  
Rick C. Williams

Victor P. Holbert  
Victor P. Holbert

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STATE OF OHIO )

COUNTY OF CLEARMONT )

I hereby certify that before me appeared Sandeep Kulkarni, personally known by me, who then and there was duly sworn by me, and under oath acknowledged that the foregoing assignment was duly signed, sealed and delivered by him on the date appearing at the foot thereof.

Date: 7/23/02  
Notary Public

My Commission Expires:

June 5, 2004

\*\*\*\*\*

STATE OF OHIO )

COUNTY OF CLEARMONT )

I hereby certify that before me appeared Yuan Ling, personally known by me, who then and there was duly sworn by me, and under oath acknowledged that the foregoing assignment was duly signed, sealed and delivered by him on the date appearing at the foot thereof.

Date: 7/23/02  
Notary Public

My Commission Expires:

June 5, 2004

\*\*\*\*\*

STATE OF NEW YORK )

COUNTY OF ORANGE )

I hereby certify that before me appeared Rick C. Williams, personally known by me, who then and there was duly sworn by me, and under oath acknowledged that the foregoing assignment was duly signed, sealed and delivered by him on the date appearing at the foot thereof.

Date: 7/29/02

Notary Public

  
My Commission Expires:AVIS L. NORTON  
Notary Public, State of New York  
Qualified in Orange County  
#4700803

\*\*\*\*\*

Term Expires

1/31/06

STATE OF OHIO )

COUNTY OF CLEARMONT )

I hereby certify that before me appeared **Victor P. Holbert**, personally known by me, who then and there was duly sworn by me, and under oath acknowledged that the foregoing assignment was duly signed, sealed and delivered by him on the date appearing at the foot thereof.

Date: 7/23/02  
Notary Public

My Commission Expires:

June 8, 2004

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